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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,149	01/05/2001	Miwako Doi	05225.0193	3467
22852	7590	01/11/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			TIV, BACKHEAN	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/754,149

**Applicant(s)**

DOI ET AL.

**Examiner**

Backhean Tiv

**Art Unit**

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/04/05 04:21:02, 4/02, 1/01</u>   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

Claims 1-24 are pending in this Office Action. Applicant's election without traverse of claims 5-16 on 5/26/04 is acknowledged. This action is in response to the amendment filed on 11/3/04.

**Priority**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

**Information Disclosure Statement**

The information disclosure, statements filed 11/03/04, 5/26/04, 7/25/02, 4/25/02, 1/5/01 has been considered.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6,14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of US Patent 6,058,311 issued to Tsukagoshi.

As per claim 5, 14, Naidoo teaches a service providing system, comprising: a service provider configured to provide a service dependent on location information of a mobile terminal to the mobile terminal in response to a service request with the location information sent by the mobile terminal(Fig.4, col.2, lines 60-64); a user non-

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identification service provider configured to provide a service not requiring a user identification to the mobile terminal(col.3,lines 59-col.4 line 10); a communication control unit configured to control communication among the mobile terminal, said user identification service provider, and said user non-identification service provider(Fig.4; it is implicit that there is a communication control unit to control communication between the mobile terminal and the service provider because if there wasn't a control unit then the mobile device would not be able to communicate with the service provider)

Naidoo however does not explicitly teach a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the user; wherein said communication control unit converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier.

Tsukagoshi teaches a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the user(col.2, lines 1-15); wherein said communication control unit converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier(col.1, line 67-col.2, line3) and also teaches a communication control unit configured to control communication among the mobile terminal, said user identification service provider, and said user non-identification service provider(Fig.1-9) .

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo to a user identification service provider configured to provide a service requiring a user identification to a mobile terminal of the

user; wherein said communication control unit converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier as taught by Tsukagoshi in order to obtain service outside of a mobile terminals home area(Tsukagoshi, col.1, lines 1-30).

One of ordinary skilled in the art at the time of the invention would have been motivated to combine Naidoo, and Tsukagoshi to provide a system in which a user with a mobile device can obtain service outside it's home network area.

As per claim 6, the service providing system according to claim 5, further comprising: a location information provider configured to provide the location information to the mobile terminal in response a location information request sent by the mobile terminal(Naidoo, col.4, lines 31-48).

As per claim 15, the service providing system according to claim 14, wherein said communication control unit sends a user identification service request including the a temporary identifier to said user identification service provider in response to a user identification service request sent by the mobile terminal(Tsukagoshi, col.1, lines 52-58). Motivation to combine set forth in claim 14.

As per claim 16, the service providing system according to claim 15, wherein said communication control unit sends a user non-identification service request without the temporary identifier to said user non-identification service provider in response to a user non-identification service request sent by the mobile terminal(Naidoo, col.3, line 59- col.4, line 10).

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of US Patent 6,058,311 issued to Tsukagoshi in further view of US Patent 6,330,598 issued to Beckwith et al.(Beckwith).

Naidoo in view of Tsukagoshi teaches all the limitations of claim 5, and further teaches as per claim 7, the service providing system according to claim 5, wherein said communication control unit stores communication control information consisting of a service request identifier(Tsukagoshi, col.1, lines 59-67), the location information(Naidoo, col.4, lines 46-48), the temporary identifier(Tsukagoshi, col.1, lines 59-67)and a parameter in response to the service request(Naidoo, col.8, lines 26-40) and the location information sent by the mobile terminal(Naidoo, col.4, lines 46-48).

Naidoo in view of Tsukagoshi however does not teach a service provider name.

Beckwith teaches a service provider name(col.10,lines 28-30).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo in view of Tsukagoshi to explicitly add a service provider name as taught by Beckwith in order to manage a subscription package of services.

One skilled in the art would have been motivated to combine Naidoo and Tsukagoshi and Beckwith in order to manage a subscription package of service(Beckwith, col.10, lines 44-46).

As per claim 8, the service providing system according to claim 7, wherein said communication control unit sends service request information consisting of the service request identifier, the service provider name, the location identifier, and the parameter

to said service provider(Naidoo, col.4, lines 31-47; Naidoo teaches sending information from the communication device to the content provider). One skilled in the art would have been motivated to combine Naidoo and Tsukagoshi and Beckwith in order send information between the communication device and the service provider.

As per claim 9, the service providing system according to claim 8, wherein said service provider stores service request information consisting of the service request identifier(Naidoo, col.8, lines 25-41), a wireless gateway identifier of said communication control unit(Tsukagoshi, Fig.2-4), the location information and the parameter in response to the service request information sent by said communication control unit(Naidoo, col.8, lines 25-41). One skilled in the art would have been motivated to combine Naidoo and Tsukagoshi and Beckwith in order store information of the requested information.

As per claim 10, the service providing system according to claim 9, wherein said service provider creates service information by referring to the parameter, and sends service response information consisting of the service request identifier, the location information and the service information to said communication control unit(Naidoo,col.4, lines 31-48).

As per claim 11, the service providing system according to claim 10, wherein said communication control unit reconverts the temporary identifier corresponding to the service response identifier in the service response information to the user identifier in response to the service response information sent by said service provider, and sends the service information to the mobile terminal of the user identifier(Tsukagoshi, Fig.8C) .

One skilled in the art would have been motivated to combine Naidoo and Tsukagoshi and Beckwith for the same reason set forth in claim 8.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of US Patent 6,058,311 issued to Tsukagoshi in further view of US Patent 6,636,489 issued to Fingerhut.

Naidoo in view of Tsukagoshi teaches all the limitations of claim 5, however does not teach as per claim 12, the service providing system according to claim 5, further comprising: a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit.

Fingerhut teaches a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit(col.1, lines 41-64).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo in view of Tsukagoshi to explicitly add a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit as taught by Fingerhut in order to provide a wireless subscription management system.



One skilled in the art would have been motivated to combine Naidoo and Tsukagoshi and Fingerhut in order provide a wireless subscription management system(Fingerhut, col.1, lines 39-41).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,629,136 issued to Naidoo in view of US Patent 6,058,311 issued to Tsukagoshi in further view of US Patent 6,636,489 issued to Fingerhut in further view of US Patent 6,330,598 issued to Beckwith et al.(Beckwith).

Naidoo in view of Tsukagoshi in further view of Fingerhut teaches all the limitations of claim 12, and further teaches as per claim 13, the service providing system according to claim 12, wherein said communication control unit stores communication control information consisting of the service request identifier (Tsukagoshi, col.1, lines 59-67), the temporary identifier(Tsukagoshi, col.1, lines 59-67) and the parameter in response to the service request information irrelevant of the location sent by the mobile terminal(Naidoo, col.8, lines 26-40), and sends the service request information which is the same as the communication control information to said location independent service provider(Fingerhut, col.1, lines 41-52).

Naidoo in view of Tsukagoshi in further view of Fingerhut does not teach, however, the service provider name.

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Naidoo in view of Tsukagoshi in further view of

Fingerhut to explicitly add a service provider name as taught by Beckwith in order to manage a subscription package of service.

One skilled in the art would have been motivated to combine Naidoo and Tsukagoshi and Fingerhut and Beckwith in order to manage a subscription package of service(Beckwith, col.10, lines 44-46).

### ***Response to Arguments***

Applicant's arguments, see page 2-3, filed 11/3/04, with respect to the rejection(s) of claim(s) 5-16 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made. See above rejection.

The applicant also pointed out that the IDS filing dates noted in the Non-Final Action mailed on 8/03/04 were incorrect, the examiner agrees. The correct dates are cited above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1/8/05

  
**ZARNI MAUNG**  
SUPERVISORY PATENT EXAMINER